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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,660	09/15/2003	Hyun Jin Kim	0EKM-101145	1852
7590	04/29/2005			EXAMINER
Sheppard, Mullin, Richter & Hampton LLP 48th Floor 333 South Hope Street Los Angeles, CA 90071			BUTTNER, DAVID J	
			ART UNIT	PAPER NUMBER
			1712	

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/662,660	KIM ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	David Buttner	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-32 is/are pending in the application.
  - 4a) Of the above claim(s) 9, 11, 12 and 25-32 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-8, 10, 13-24 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____.   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____.                                   |

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-24, drawn to silicone compositions, classified in class 525, subclass 105.
- II. Claims 25-32, drawn to a golf ball, classified in class 473, subclass 371.

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product (the composition) can be used to make cable sheathing, tubes etc.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention: various crosslinkers.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-8 and 13-32 generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with James Brueggemann on 4/22/05 a provisional election was made with traverse to prosecute the invention of I with precious metal crosslinker, claims 1-8,10 and 13-24. Affirmation of this election must be made by applicant in replying to this Office action. Claims 9,11,12 and 25-32 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7,16 and 21 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7's "polysiloxane" cannot qualify as a non-silicone.

Claim 16 cannot form a single phase because by definition, IPN's have multiple phases.

Claim 21 does not permit a necessary step of claim 20 from taking place. Claim 21 cannot depend on claim 20.

Claim 21 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 21 does not include all the limitations of claim 20.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,2,4-8,10,13,15,16,18,21 and 24 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Zolotnitsky '426 Patent.

Zolotnitsky produces a semi IPN of thermoplastic, silicone and platinum catalyst (abstract).

Claims 1,3-8,13-16,18,21 and 24 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Liu '644 Patent.

Liu polymerizes an olefinic monomer in the presence of a silicone resin (abstract). Both crosslink to form an IPN (col 2 line 63-66). According to applicant (paragraph 4 of spec), a full IPN results when both polymers are crosslinked. A cure promoter such as butylperbenzoate (col 3 line 49) can be included. This qualifies as applicant's crosslinking agent.

Claims 1,3-7,13,14,16-18 and 24 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Birnholz '375.

Birnholz forms an IPN of silicone, epoxy, crosslinking agent and catalyst (abstract). The epoxy forms domains within the silicone (col 2 line 18). Both phases are cured and therefore must be considered a full IPN.

Claims 1-8,13-19 and 24 rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kuntimaddi 2002/0187857.

Kuntimaddi suggests golf balls having an IPN structure (abstract). The IPN may be a semi IPN also (paragraph 59). One of the polymers making up the IPN can be polysiloxane (paragraph 31). Crosslinkers (paragraph 88) can be included. Use of a polysiloxane with a crosslinker would be at least obvious if not considered anticipatory due to the number of choices in the reference.

Claims 1,3-8,10,13-18 and 24 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Takemura '977.

Takemura exemplifies dynamically crosslinking blends of polybutadiene, silicone materials and platinum catalyst (table 1). Takemura does not report the morphology of the resultant composition. However, applicant indicates routine mixing of the components will form the IPN (page 20 of spec). Furthermore, Saito '144 (col 1 line 60-62) teaches dynamic crosslinking forms IPN's. For these reasons, it is believed Takemura's blend will inherently form an IPN.

Claims 18-24 rejected under 35 U.S.C. 103(a) as being unpatentable over Zolotnitsky '426 or Kuntimaddi 2002/0187857 or Takemura '977 optionally in view of the Polymer Mixing Technology text.

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Zolotnitsky, Kuntimaddi and Takemura do not teach dry blending the ingredients prior to melt mixing or any particular mixing sequence. Dry blending prior to melt mixing is a common technique known to all in the polymer processing art (see fig 1.1 of Polymer Mixing Technology). Furthermore, any mixing order is generally considered *prima facie* obvious (*In re Hampel* 74 USPQ 171).

It would have been obvious to dry blend the ingredients Zolotnitsky/Kuntimaddi/Takemura and mix in any order. Only the expected results are obtained.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is 571-272-1084. The examiner can normally be reached on weekdays from 10 to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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David Buttner

DAVID J. BUTTNER  
PRIMARY EXAMINER

4/25/05

